



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/721,962

11/25/2003

Robert M. Herrin

7703.26

5936

39313 7590 12/19/2008

CARL M. NAPOLITANO, PH.D.  
ALLEN, DYER, DOPPELT, MILBRATH & GILCHRIST, P.A.  
255 SOUTH ORANGE AVE., SUITE 1401  
P.O. BOX 3791  
ORLANDO, FL 32802-3791

EXAMINER

HARMON, CHRISTOPHER R

ART UNIT

PAPER NUMBER

3721

MAIL DATE

DELIVERY MODE

12/19/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

*Ex parte* ROBERT M. HERRIN

---

Application No. 10/721,962  
Technology Center 3700

---

Mailed: December 18, 2008

---

Before PAMELA S. BENNETT, *Review Team Paralegal*  
BENNETT, *Review Team Paralegal*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on December 2, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matter requiring attention prior to docketing.

### **APPEAL BRIEF, GROUNDS OF REJECTION**

A review of the file finds that the grounds of rejection of the claims as provided in the Appeal Brief filed May 19, 2008 under the heading “Grounds of rejection to be reviewed on appeal” is unclear and/or is not consistent with the grounds of rejection of claims of record. The grounds of rejection of the claims as provided in the Appeal Brief must be consistent with the last Office action of record, including any Advisory action responsive to any after final submissions. Each Grounds of rejection to be reviewed on appeal must be identified.

A review of the last Office action [Final Rejection mailed November 8, 2007], including any mailed Advisory Action(s) finds that “[c]laims 57-58 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Royal (US-3,978,774) in view of Official Notice” [page 4]; whereas Appellant has either not indicated the grounds of rejection of these claims or has improperly listed only that “[c]laim 57 is unpatentable under 35 U.S.C. § 103(a) over Royal in view of Official Notice taken by the Examiner” [page 22]. Correction of the Grounds of rejection to be reviewed on appeal for all claims is required.

### **APPEAL BRIEF, HEADINGS**

A review of the file indicates that the Appeal Brief filed May 19, 2008 does not comply with 37 CFR § 41.37(c) (2007) because it does not contain all required heading items. Specifically, 37 CFR § 41.37(c)(1) requires the following heading items in the following order:

- (i) *Real party in interest.*

- (ii) *Related appeals and interferences.*
- (iii) *Status of claims.*
- (iv) *Status of amendments.*
- (v) *Summary of claimed subject matter.*
- (vi) *Grounds of rejection to be reviewed on appeal.*
- (vii) *Argument.*
- (viii) *Claims appendix.*
- (ix) *Evidence appendix.*
- (x) *Related proceedings appendix.*

An in-depth review of the Appeal Brief indicates that the following section is missing from the Appeal Brief filed May 19, 2008 and/or is not complete:

(viii) *Claims appendix.* An appendix containing a copy of the claims involved in the appeal.

According to the “Status of the Claims” appearing on page 5 of the Appeal Brief, “[c]laims 1-19 and 48-58 stand rejected and are pending in the application. Claims 20-45 have been withdrawn. Claims 46-47 were withdrawn by the Examiner.” However, it is noted that Claims Appendix is missing copies of claims 2-5, 10, 12, 13, 15-19, 50, 52, 55, 56 and 58. Correction is required.

### **CONCLUSION**

Accordingly, it is **ORDERED** that the application is returned to the Examiner:

- 1) to hold the Appeal Brief filed May 19, 2008 defective;
- 2) for notification to appellant to file a revised Appeal Brief in compliance with 37 CFR § 41.37 which corrects the “Grounds of Rejection to be Reviewed on Appeal,” “Argument” and “Claims Appendix”;
- 3) for consideration of said revised Appeal Brief; and
- 4) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

PSB

Carl M. Napolitano, PH.D  
Allen, Dyer, Doppelt, Milbrath & Gilchrist, P.A.  
255 South Orange Avenue, Suite 1401  
P.O. Box 3791  
Orlando, FL 32802-3791